

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

ASTOR CHOCOLATE CORP.,

Plaintiff,

-v-

FOOD DEPOT CORPORATION, ORANGE GROCER,
FOOD INDUSTRIES, and TAKARI INTERNATIONAL,
INC.,

Defendants.

18 Civ. 11913 (PAE)

ORDER

PAUL A. ENGELMAYER, District Judge:

Defendants move to stay this action pending the TTAB proceeding. That motion implicates the primary jurisdiction doctrine, which “guards against premature judicial encroachment upon an agency’s sphere of responsibility and expertise.” *Goya Foods, Inc. v. Tropicana Prods, Inc.*, 846 F.2d 848, 853 (2d Cir. 1988); *see Ellis v. Tribune Television Co.*, 443 F.3d 71, 83 (2d Cir. 2006). Considering such applications, courts in this Circuit typically consider whether the question (1) falls within the conventional expertise of judges, or, instead, matters within an agency’s expertise; (2) “is particularly within the agency’s discretion”; (3) raises “substantial danger” of inconsistent rulings; and (4) has been the subject of a prior application to the agency. *Ellis*, 443 F.3d at 82–83. Courts must also “balance the advantages of applying the doctrine against the potential costs” of doing so, given potential “complications and delay in the administrative proceedings.” *Id.* at 83 (quoting *Nat’l Commc’ns Ass’n, Inc. v. AT&T Co.*, 46 F.3d 220, 223 (2d Cir. 1995)).

Such a case-specific evaluation is unnecessary, however, in suits involving trademark infringement. The Second Circuit has held that, in such cases, “the interest in prompt

adjudication far outweighs the value of having the views of the [USPTO].” *Goya Foods*, 846 F.2d at 853–54. Plaintiff is entitled to a prompt resolution of its claim for infringement, and delaying resolution “undercuts the purpose of declaratory relief.” *Id.* at 854; *see also, e.g., RLP Ventures LLC v. All Hands Instruction NFP*, No. 18 Civ. 3988 (RWS), 2019 WL 1316030, at *7 (S.D.N.Y. Mar. 22, 2019) (denying motion to stay because infringement was at issue in district court); *Classic Liquor Importers, Ltd. v. Spirits Int’l B.V.*, 151 F. Supp. 3d 451, 459 (S.D.N.Y. 2015) (rejecting defendant’s request that court not exercise jurisdiction as a possible abuse of discretion under *Goya Foods* and because TTAB had already stayed proceedings in deference to the litigation in question). The Court therefore denies defendants’ motion to stay this action.

SO ORDERED.



PAUL A. ENGELMAYER
United States District Judge

Dated: October 28, 2021
New York, New York